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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 005127.00179							
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Application Number 10/700,043	Filed November 4, 2003								
First Named Inventor Derek CAMPBELL, et al.									
Art Unit 3781	Examiner Mai, Tri M								
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.									
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>57,019</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		_____ /Elizabeth A. Almeter/ Signature _____ Elizabeth A. Almeter Typed or printed name _____ (202) 824-3000 Telephone number _____ June 19, 2008 Date							
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.									

☐ *Total of _____ forms are submitted.

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Derek CAMPBELL *et al.*

Serial No.: 10/700,043

Filed: November 4, 2003

For: GOLF BAG BASE

Atty. Docket No.: 005127.00179

Group Art Unit: 3781

Examiner: Mai, Tri M.

Confirmation No.: 3120

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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U.S. Patent and Trademark Office
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401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the final Office Action dated February 7, 2008, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific error relied upon in this Pre-Appeal Brief Request for Review includes the following:

- The Office made clear error in relying on U.S. Patent No. 6,938,762 to Cheng (hereinafter “Cheng ‘762”), in its rejection of claims 1, 4-11, 15-16, 20-28, 33, 34, and 36, as argued in Applicant’s Amendment and Response filed December 20, 2007, at pp. 12-13. In the Office’s final Office Action dated February 7, 2008, the Office States that the evidence provided in Applicants’ Declaration under Rule 1.131 is inadequate and inconsistent. *See* the final Office Action dated

February 7, 2008 at p. 5. Applicants respectfully disagree. In the final Office Action of September 21, 2007, the Office asserts that the “declaration fails to show that the bottom is made from one piece.” See the Final Office Action at p. 5. Applicants respectfully disagree. Several exhibits filed with the Declaration depict the bottom as being one piece. For instance, Exhibit C shows a one piece bottom. Durable inserts are shown in the figure but, as indicated in the exhibit, they are only included “as needed.” See Declaration Exhibit C filed March 19, 2007. In addition, Exhibit D, E, F and G depict the bottom as a single piece. Additional durable inserts are shown in Exhibit E. However, these inserts do not detract from the base itself being a single piece. Accordingly, Applicants respectfully assert that the Declaration filed does indeed show the base as being a single piece, as recited in independent claims 1, 20, and 38. Applicants have clearly stated in the Declaration where support for various claim features, particularly the features of independent claims 1, 20 and 38 are supported in the Declaration. Accordingly, Applicants respectfully assert that the evidence presented in the Declaration is sufficient to establish a date of conception and reduction to practice prior to May 28, 2003, the filing date of Cheng ‘762. Cheng ‘762 is therefore not valid as prior art against the present claims, and Applicants respectfully request withdrawal of these rejections.

- The Office made clear error in relying on U.S. Patent No. 6,386,362 to Cheng (hereinafter “Cheng ‘362”) in its rejection of claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34, as argued in Applicants’ Amendment and Request for Continued Examination filed December 20, 2008. The Office asserts that “Cheng ‘362 teaches a golf bag having a base including a one-piece element that extends around the second of the body and forms a support surface and defining a flexion line defining two pivotable portions.” See the final Office Action dated February 7, 2008 at p. 2. Applicants respectfully disagree. Cheng ‘362 describes a golf bag including a base seat that includes a front section, a rear section and a pivot section connected between the front and rear sections. Col. 2, lines 65-67. Cheng ‘362 clearly fails to teach or suggest a base *formed of a single piece* element extending substantially around the second end of the body. Rather, Chang ‘362 describes a multi-part base having a pivot section (40 in Figures 1-7) that is formed of a flexible material to facilitate bending of the base. Col. 3, lines 17-20. The pivot section is *connected between* the front and rear sections. Further, Cheng describes the front and rear sections as “halves of the base seat and the pivot section is positioned at the center of the base seat.” See Cheng ‘362 col. 4, lines 21-23. Cheng also describes the front and rear sections as able to be “*connected by an alternative measure*” rather

than by the aforesaid pivot section. *Id* at col. 4, lines 8-11. (Emphasis added) Therefore, Cheng ‘362 clearly fails to teach or suggest a base formed of a single piece element, as recited in independent claims 1 and 20. Accordingly, Applicants respectfully assert that claims 1 and 20 are patentably distinct from Cheng ‘362.

- The amendments made in the Amendment and Request for Continued Examination filed December 20, 2008 were made in response to the assertion by the Office that the previously used claim term “‘one piece’ is broad and does not exclude the other part coming together to form one piece item.” *See* the Final Office Action dated September 21, 2007 at p. 4-5. Further, the Office asserts that the amended term “single piece” is broad and does not exclude the base of Cheng ‘362. *See* the final Office Action dated February 7, 2008 at p. 4-5. While Applicants do not agree with the assertion of the Office, Applicants assert that a base made from a plurality of parts, as described in Cheng ‘362, clearly can not be considered *formed of a single piece element*, as recited in claims 1 and 20.
- The Office made clear error in relying on U.S. Patent No. 6,568,527 to Te-Pin (hereinafter “Te-Pin”) in its rejection of claims 1, 4-11, 15, 16, 18, 20-28, 33, 34 and 36, as argued in Applicants’ Amendment and Request for Continued Examination filed December 20, 2007. The Office asserts that “Te-Pin teaches a golf bag having a base including a one-piece element that extend around the second of the body and forms a support surface and defining a flexion line defining two pivotable portions.” Applicants respectfully disagree. Te-Pin describes a golf bag that includes a base bracket. Col. 2, lines 48-49. The base bracket includes a front section, a rear section, a first flexible section disposed on the front section, a second flexible section disposed on the rear section and a connecting member connected between the first and second flexible sections. *See* Col. 2, lines 57-61 and FIGS. 1, 2, 4 and 5. The connecting member is disposed between the first and second flexible sections and is connected with outer edges of corresponding portions thereof. Col. 3, lines 33-35. A part of the connecting member is connected with the first and second flexible sections on the bottom of the base bracket, while another part is connected with the first and second flexible sections on the lateral side of the base seat. Col. 3, lines 35-40. The first and second sections are “connected together to form a larger receiving space.” Col. 3, lines 40-41.
- The Office asserts that the term “single piece” is broad and does not exclude the base of Te-Pin. *See* the final Office Action dated February 7, 2008 at p. 4-5. Applicants respectfully disagree. Clearly, Te-Pin fails to teach or suggest a base formed of a single piece element that extends

substantially around the second end of the body. In fact, Te-Pin describes a base including multiple parts connected together. For instance, the connecting member of Te-Pin is “bridged and connected between the first and second flexible sections by way of stitching.” Col. 4, lines 15-17. Note also Figs. 2, 4 and 5 of Te-Pin. As such, Te-Pin specifically teaches away from a base formed of a single piece element that extends substantially around the second end of the body, as recited in claims 1 and 20. Applicants respectfully assert that independent claims 1 and 20 patentably distinguish from Te-Pin and request withdrawal of this rejection.

- The Office made clear error in relying on U.S. Patent No. 6,564,937 to Cheng (hereinafter “Cheng ‘937”) in its rejection of claims 1, 4, 7-11, 15, 16, 18, 20-27, 33, 34 and 36, as argued in Applicants Amendment and Request for Continued Examination filed December 20, 2007. The Office asserts that “Cheng ‘937 teaches a golf bag having a base including a one-piece element that extend around the second of the body and forms a support surface and defining a flexion line defining two pivotable portions.” See the final Office Action dated February 7, 2008 at p. 2. Applicants respectfully disagree. Cheng ‘937 describes a golf bag including a base having a front section and a rear section. Col. 3, lines 3-4. The bottom of the front section is open and a driving board is connected to the front section via a connecting structure. Col. 3, lines 12-31. The golf bag base of Cheng ‘937 includes multiple parts. See FIGS. 2 and 3. Clearly, Cheng ‘937 fails to teach or suggest a base formed of a single piece element that extends substantially around the second end of the body. Although the Office asserts that the term “single piece” is broad and does not exclude Cheng ‘937, Applicants respectfully disagree and assert that at least independent claims 1 and 20 are patentably distinct from Cheng ‘937.
- The Office made clear error in relying on Cheng ‘762, Cheng ‘362, Cheng ‘937 or Te-Pin, either alone or in combination with U.S. Patent Publication No. 2004/0200746 to Kang (hereinafter “Kang”) or U.S. Patent No. 3,941,398 to Nelson (hereinafter “Nelson”) in its rejection of claims 2, 29, 30, 38, 40-43, 46 and 47, as argued in Applicants Amendment and Request for Continued Examination filed December 20, 2007. Claims 2 and 29-30 depend from claims 1 and 20, respectively. As discussed above, none of the Cheng references or Te-Pin teaches or suggests all the features of claims 1 and 20. The addition of Kang or Nelson fails to cure the deficiencies of the Cheng references or the Te-Pin reference with respect to claims 1 and 20. Accordingly, Applicants

respectfully assert that claims 2, 29 and 30 are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein.

- The Office asserts that the Kang and Nelson references teach a base made of foam. However, this feature is not recited in independent claim 38. Independent claim 38 recites features similar to those recited in claims 1 and 20. For example, claim 38 recites, among other features, “[a] golf bag comprising: ...a base secured to the second end of the body, the base *formed of a single piece* element that extends substantially around the second end of the body” (Emphasis added). None of Cheng ‘762, Cheng ‘362, Cheng ‘937 or Te-Pin teaches or suggests the features of claim 38. The addition of Kang or Nelson fails to cure the deficiencies of these references with respect to claim 38 because neither Kang nor Nelson, alone or in combination, teaches or suggests this base formed of a single piece element. Accordingly, Applicants respectfully assert that claim 38 is allowable over the cited references.

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. Applicants further reserve the right to address the rejections of any other claims not identified above on appeal should the appeal of this case proceed after the Office’s consideration of this paper.

CONCLUSION

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3174.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: June 19, 2008

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